

### **REMARKS / ARGUMENTS**

By this Amendment and RCE filed herewith, Applicants respond to the Office Action dated September 9, 2004 ("the Office Action"), in which Claims 121-140 were rejected. By this Amendment, claims 121, 132, 134, and 136-139 have been amended, and new Claims 141-150 have been added. Accordingly, Claims 121-150 are now pending.

#### **Drawings**

Applicants submit herewith replacement drawings, for which the informalities noted by the Office have been corrected. No new matter has been added.

#### **Rejection of Claims 121-123, 125-129, and 134-140 under 35 U.S.C. § 102(e)**

The Office Action rejected Claims 121-123, 125-129, and 134-140 under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 5,715,403 to Stefik ("Stefik"). Applicants respectfully submit that the pending claims are allowable over Stefik for at least the reasons described herein.

Amended Claim 121 recites, *inter alia*, a rights management method that includes (i) receiving a request from a user to access electronic content, the electronic content having associated with it a control set specifying two or more alternative conditions for governing access to or other use of the electronic content, and (ii) using at least one digital certificate associated with the user to select one of the conditions.

Applicants respectfully submit that Stefik does not teach or suggest, *inter alia*, using a digital certificate associated with a user to select between two or more alternative conditions for governing the use of electronic content. Instead, the cited portions of Stefik describe a general requirement that a user have an authorization certificate before exercising a particular right associated with a repository containing a digital work (see, e.g., Office Action at page 3, citing Stefik, col. 31 lines 15-21 and FIG. 18, step 1801). Indeed, Stefik indicates that these general tests "correspond to requirements imposed on the work as a consequence of its being on the particular repository, **as opposed to being attached to the work itself.**" (Stefik, col. 31, lines

12-15)(emphasis added). In contrast, Applicants' Claim 121 indicates that the control set specifying the alternative conditions is associated with the content itself.

Moreover, the authorization certificates in Stefik are not used to **select** between two or more alternative conditions for governing use of electronic content. Instead, to the extent Stefik describes multiple versions of a right to a digital work—e.g., “a PRINT right to make 5 copies for \$10.00 and a PRINT right to make unlimited copies for \$100.00” (Stefik at col. 18, lines 14-16)—the actual selection between these rights is performed manually by the user, apparently without regard to any certificates associated with the user. See, e.g., Stefik at col. 18, lines 17-18 (“A purchaser may then choose which option best fits his needs”). In contrast, Claim 121 recites a method in which the selection between alternative conditions is performed automatically—as opposed to manually—based on a digital certificate associated with the user.

In summary, it is respectfully submitted that Stefik does not teach or suggest a method in which control sets associated with a piece of electronic content—as opposed to a repository or folder in which the content resides—include multiple conditions for governing access to the content, selection of which is performed automatically using at least one digital certificate. For at least these reasons, Applicants respectfully submit that Claim 121 is not anticipated by Stefik.

Claims 122-123 and 125-129 are dependent on Claim 121, and are thus allowable for at least the reasons set forth above in connection with Claim 121.

Similarly, Claim 134 recites a computer program product that includes instructions operable to evaluate a digital certificate associated with a user of a computer system, and to also evaluate a control set associated with a piece of electronic content to determine whether, and under which of two or more conditions selectable upon detection of a respective digital certificate, the user is authorized to access the piece of electronic content.

Applicants respectfully submit that Stefik does not teach or suggest, *inter alia*, a computer program product that includes instructions for evaluating both a digital certificate and a control set to determine whether, and under which of two or more

conditions, a user is authorized to access a piece of electronic content. Nor does Stefik teach or suggest automatically selecting between the two or more conditions based on the evaluation of the digital certificate. Instead, as discussed above, the cited portions of Stefik describe a general requirement that a user have an authorization certificate before exercising a particular right associated with a repository containing a digital work (see, e.g., Office Action at page 3, citing Stefik, col. 31 lines 15-21 and FIG. 18, step 1801). Indeed, Stefik indicates that these general tests “correspond to requirements imposed on the work as a consequence of its being on the particular repository, **as opposed to being attached to the work itself.**” (Stefik, col. 31, lines 12-15)(emphasis added). In contrast, Applicants’ Claim 134 indicates that the control set specifying the two or more conditions is associated with the content itself.

Moreover, the authorization certificates in Stefik are not used to **select** between two or more alternative conditions for governing use of electronic content. Instead, to the extent Stefik describes multiple versions of a right to a digital work—e.g., “a PRINT right to make 5 copies for \$10.00 and a PRINT right to make unlimited copies for \$100.00” (Stefik at col. 18, lines 14-16)—the actual selection between these rights is performed manually by the user, apparently without regard to any certificates associated with the user. See, e.g., Stefik at col. 18, lines 17-18 (“A purchaser may then choose which option best fits his needs”). In contrast, Claim 134 indicates that the selection between alternative conditions is performed automatically—as opposed to manually—based on a digital certificate associated with the user.

In summary, it is respectfully submitted that Stefik does not teach or suggest control sets associated with a piece of electronic content—as opposed to a repository or folder in which the content resides—that include multiple conditions for governing access to the content, selection of which is performed automatically using at least one digital certificate. For at least these reasons, Applicants respectfully submit that Claim 134 is not anticipated by Stefik.

Claims 135-140 are dependent on Claim 134, and are thus allowable for at least the reasons set forth above in connection with Claim 134.

Rejection of Claims 124 and 130-133 under 35 U.S.C. § 103(a)

Claims 124 and 130-133 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stefik in view of Dolphin (Claim 124), Weiss (Claim 130), and Rose, Jr. (Claims 131-133). However, all of the claims subject to these rejections are ultimately dependent on Claim 121, and are thus allowable for at least the reasons set forth above in connection with Claim 121.

New Claims 141-150

New Claims 141-150 have been added to round out the scope of protection for Applicants' invention. Each of Claims 141-150 is supported by the specification text and/or drawings as initially filed and no new matter has been added.

CONCLUSION

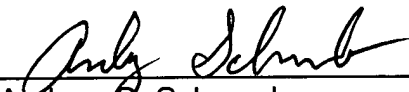
In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in allowable form. Applicants therefore request the entry of this Preliminary Amendment, reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 9, 2005

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